

ESTTA Tracking number: **ESTTA436203**

Filing date: **10/17/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91189023
Party	Plaintiff Whataburger Partnership
Correspondence Address	WILLIAM G BARBER PIRKEY BARBER LLP 600 CONGRESS AVE SUITE 2120 AUSTIN, TX 78701 UNITED STATES bbarber@pirkeybarber.com, wlarson@pirkeybarber.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com
Submission	Other Motions/Papers
Filer's Name	Jeff A. McDaniel
Filer's e-mail	jmcdaniel@dmtechlaw.com, hsimpson@dmtechlaw.com
Signature	/jeffamcdaniel/
Date	10/17/2011
Attachments	Request for Update of Ownership Information.pdf (1 page)(31338 bytes) TM Assignment Agreement.pdf (12 pages)(306159 bytes) Notice of Recordation.pdf (1 page)(65989 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

WHATABURGERPARTNERSHIP,

Opposer,

v.

SARKIS AVAKIAN,

Applicant.

§
§
§
§
§
§
§
§
§

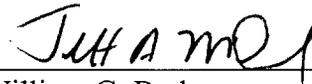
Opposition No. 91189023

REQUEST FOR UPDATE OF OWNERSHIP INFORMATION

Opposer, Whataburger Partnership, requests that the ownership information for Trademark Application Serial No. 77/494,179 for the mark WHATTA WING! be updated in the USPTO records to show the new owner information. Attached are copies of the Trademark Assignment Agreement between Sarkis Avakian and Whataburger Partnership and the Notice of Recordation of Assignment Document.

Respectfully submitted,

By:



William G. Barber
Wendy C. Larson
PIRKEY BARBER LLP
600 Congress Avenue, Suite 2120
Austin, Texas 78701
Telephone: (512) 322-5200
Telecopier: (512) 322-3201

Jeff A. McDaniel
Kirby Cronin
DAFFER MCDANIEL, LLP
700 Lavaca Street, Suite 720
Austin, Texas 78701
Telephone: (512) 476-1400
Telecopier: (512) 703-1250

ATTORNEYS FOR OPPOSER

Trademark Assignment Agreement

This Trademark Assignment Agreement (this "**Agreement**") is made and is effective as of the date of the last signature (the "**Effective Date**") by and between (1) Sarkis Avakian, an individual with a place of business at 151 Coolidge Ave. #701, Watertown, MA 02472 ("**Assignor**"), and Whataburger Partnership, with a place of business located at 300 Concord Plaza Drive, San Antonio, Texas 78216 ("**Assignee**"), as follows:

BACKGROUND

A. Assignor is the owner of the trademarks, service marks, trade names and any and all trade dress associated therewith (the "**Marks**") as described in the attached Exhibit A, together with the goodwill of the business symbolized thereby and appurtenant thereto.

B. Assignor has used the Marks on or in connection with its restaurant services and the food and beverage products sold in connection therewith (the "**Products and Services**");

C. Assignor owns United States Trademark Application No. 77/494,179 for the mark WHATTA WING! for "restaurant services," in International Class 43, filed with the United States Patent and Trademark Office on June 9, 2008 (the "**Application**");

D. Assignor owns Commonwealth of Massachusetts Trademark Registration No. 70738 for the mark WHATTA WING! for "fast food retail," in International Class 43, registered by the Secretary of the Commonwealth, Corporations Division on December 22, 2008 (the "**Registration**");

E. Assignor desires to convey, transfer, assign, deliver, and contribute to Assignee all of its worldwide rights, titles, and interests in and to the Marks (including the business goodwill symbolized thereby and appurtenant thereto), the Application, and the Registration.

NOW, THEREFORE, Assignor and Assignee, in consideration of the mutual agreements contained herein and for other good and valuable consideration, acknowledged by each of them to be satisfactory and adequate, do hereby agree as follows:

Section 1

ASSIGNMENT

1.1 Grant for the Marks. Assignor hereby conveys, transfers, assigns, delivers, and contributes to Assignee all of Assignor's worldwide rights, titles, and interests in and to the Marks, together with:

- (a) the goodwill of the business of Assignor relating to the Products and Services upon or in connection with which the Marks are used, for which the Application has been sought, and for which the Registration has been issued;
- (b) all income, royalties, and damages hereafter due or payable to Assignor with respect to the Marks, including without limitation, damages, and payments for past or future infringements, misappropriations and other unauthorized uses of the Marks;
- (c) all rights to sue for past, present, and future infringements, misappropriations, or unauthorized uses of the Marks; and
- (d) the Application and Registration.

1.2 Recordation. Assignee may request the United States Commissioner of Patent and Trademarks, the Secretary of the Commonwealth of Massachusetts or any other appropriate authority to issue in Assignee's or its nominee's name all certificates of registration for the Marks. Assignee may record the short form assignments attached hereto as Exhibit "B" with the United States Patent & Trademark Office, the Secretary of the Commonwealth of Massachusetts, Corporations Division, and any other appropriate authority as evidence of the assignments reflected in this Agreement.

Section 2

REPRESENTATIONS

- 2.1 Representations.** Assignor represents, warrants and covenants to Assignee that:
- (a) Assignor is the owner of the Marks, the Application and the Registration;
 - (b) the Assignor has not previously assigned, transferred or otherwise encumbered the rights conveyed in this Agreement;
 - (c) the Marks, the Application, and the Registration are valid and subsisting and have not been abandoned;
 - (d) there have not been and there are presently not any claims or causes of action asserted against Assignor, the subject matter of which included or includes, whether in whole or in part, the Marks, the Application, or the Registration (excluding Opposition No. 91,189,023, filed by Assignee on February 26, 2009 against the Application);
 - (e) to the best of Assignor's knowledge as of the Effective Date, the use of the Marks for the Products and Services will not constitute dilution, misappropriation or

unfair competition under state or federal law, and will not infringe any trademark, copyright or similar right of any person or entity;

- (f) to the best of Assignor's knowledge as of the Effective Date, no other person or entity has any claim to any rights, titles or interests in or to the Marks, the Application, or the Registration (excluding those rights, titles or interests asserted by Assignee);
- (g) all statements made to the United States Patent & Trademark Office in connection with the Application are true;
- (h) all statements made to the Secretary of the Commonwealth, Corporations Division for the Commonwealth of Massachusetts in connection with the application for the Registration are true; and
- (i) except for the Application and the Registration, Assignor owns no other applications or registrations in any jurisdiction for (i) the Marks, (ii) any trademark, service mark, trade name, insignia or logo that is confusingly similar to the Marks (including without limitation, translations of the Marks into foreign languages), or (iii) any colorable imitations of the Marks.

Section 3

FURTHER ASSURANCES

3.1 Further Assurances. Assignor shall execute, acknowledge and deliver such further instruments and take such further actions as may be necessary or desirable to evidence more fully the transfer of ownership of, or the validity and enforceability of, the Marks, the Application, and the Registration, to Assignee. Assignor therefore agrees within thirty (30) days of request, and without further consideration, to:

- (a) execute, acknowledge, and deliver any affidavits or documents of assignment and conveyance regarding the Marks, the Application, or the Registration;
- (b) cooperate fully with Assignee in any action, proceeding or other effort affecting the rights, titles, or interests of Assignee in the Marks, the Application, the Registration, including without limitation, providing such information, affidavits and testimony as Assignee may require; and
- (c) perform any other acts deemed necessary to carry out the intent of this Agreement.

Section 4

MISCELLANEOUS

4.1 Authority and General Warranties. Each party represents and warrants to the other that it is duly existing; that it has full power and authority to enter into this Agreement; that this Agreement does not and will not interfere with any other agreement to which it is a party; that it will not enter into any agreement the execution or performance of which would violate or interfere with this Agreement.

4.2 Modifications and Waivers. This Agreement may not be modified nor may any provision hereof be waived without the prior written consent of the party against whom such modification or waiver is asserted. No delay or omission by either party to exercise any right or power shall impair any such right or power or be construed to be a waiver thereof. A waiver of any provision of this Agreement on any occasion shall not constitute a waiver of such provision on any succeeding occasion. Unless stated otherwise, all remedies available under this Agreement shall be cumulative and in addition to and not in lieu of any other remedies available at law, in equity or otherwise.

4.3 Entire Agreement. This Agreement constitutes the sole understanding of the parties with respect to the subject matter hereof.

4.4 Survival of Representations. The representations made in this Agreement shall survive its execution.

4.5 Headings; Exhibits. The headings used herein are for reference and convenience only and shall not enter into the interpretation hereof. The exhibits referred to in this Agreement are incorporated into this Agreement to the same extent as if set forth in full herein.

4.6 Severability. If, but only to the extent that, any provision of this Agreement is declared or found to be illegal, unenforceable or void, then both parties shall be relieved of all obligations arising under such provision, it being the specific intent and agreement of the parties that this Agreement shall be deemed amended by modifying such provision to the minimum extent necessary to make it legal and enforceable while preserving its intent. It is the specific intent and request of the parties that the court or other adjudicative body called upon to interpret or enforce this Agreement modify such provision to the minimum extent necessary so as to render it enforceable. If such amendment is not possible, another provision that is legal and enforceable and achieves the same objectives shall be substituted therefor. If the remainder of this Agreement is not affected by such declaration or finding and is capable of substantial performance by the parties, then the remainder shall be enforced to the extent permitted by law.

4.7 Representation of Counsel; Mutual Negotiation. Each party has had the opportunity to be represented by counsel of its choice in negotiating this Agreement. This Agreement shall therefore be deemed to have been negotiated and prepared at the joint request,

direction, and construction of the parties, at arms length, with the advice and participation of counsel, and will be interpreted in accordance with its terms without favor to any party.

4.8 Counterparts. This Agreement is executed in two counterparts, each of which taken together shall constitute one single Agreement between the parties.

IN WITNESS WHEREOF, the parties hereto have duly executed and delivered this Agreement as a sealed instrument, as of the day and year first above written.

Assignor



Signature

9-29-11

Date

Assignee



Signature

Thomas E. Dobson

Typed or Printed Name

Chairman & CEO

Title

9-21-2011

Date

[ACKNOWLEDGEMENT FOR THE ASSIGNOR]

STATE OF §
COUNTY OF §

BEFORE ME, the undersigned Notary Public, on this day personally appeared Sarkis Avakian, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he has executed same for the purposes and considerations therein expressed.

GIVEN under my hand and seal of office, this 29 day of September, 2011.

[Signature]
Notary Public in and for the State of Texas

[ACKNOWLEDGEMENT FOR THE ASSIGNEE]

STATE OF §
COUNTY OF §

BEFORE ME, the undersigned Notary Public, on this day personally appeared Thomas E. Dobson, known to me to be the person and officer whose name is subscribed to the foregoing instrument and acknowledged to me that the same was the act of Whataburger Partnership, a general partnership, and that he/she has executed same as the act of such partnership for the purposes and considerations therein expressed, and in the capacity therein stated.

GIVEN under my hand and seal of office, this 21st day of September, 2011.



[Signature]
Notary Public in and for the State of Texas

Exhibit A

THE MARKS

**WHATTA WING!
WHATTA DEAL
WHATTA SPECIAL**

WHATTA WING !

Exhibit B

SHORT FORM ASSIGNMENTS

NOTICE OF ASSIGNMENT OF MARK

WHEREAS, Sarkis Avakian, an individual with a place of business at 151 Coolidge Ave. #701, Watertown, MA 02472 ("**Assignor**") has adopted and is using the following mark for which the following United States Trademark Application has been filed:

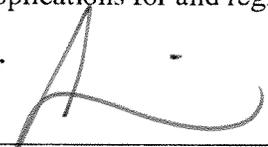
<u>Mark</u>	<u>Serial No.</u>
WHATTA WING! (Special Form)	77/494,179

WHEREAS, Whataburger Partnership, with a place of business located at 300 Concord Plaza Drive, San Antonio, Texas 78216 ("**Assignee**"), desires to acquire any and all rights and goodwill associated with the above-referenced mark and all applications for and registrations of the mark;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor does hereby assign to Assignee all right, title and interest in and to said mark, together with the goodwill of the business symbolized by the mark and all applications for and registrations of the mark.

Assignor

Signature



Date

9-29-11

NOTICE OF ASSIGNMENT OF MARK

WHEREAS, Sarkis Avakian, an individual with a place of business at 151 Coolidge Ave. #701, Watertown, MA 02472 ("**Assignor**") has adopted and is using the following mark for which the following the Secretary of the Commonwealth of Massachusetts, Corporations Division, has issued the following registration:

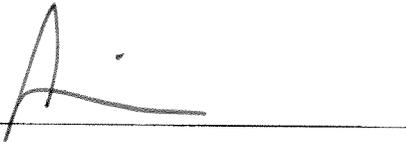
<u>Mark</u>	<u>Registration No.</u>
WHATTA WING!	70738

WHEREAS, Whataburger Partnership, with a place of business located at 300 Concord Plaza Drive, San Antonio, Texas 78216 ("**Assignee**"), desires to acquire any and all rights and goodwill associated with the above-referenced mark and all applications for and registrations of the mark;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor does hereby assign to Assignee all right, title and interest in and to said mark, together with the goodwill of the business symbolized by the mark and all applications for and registrations of the mark.

Assignor

Signature



Date

9-29-11



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCTOBER 11, 2011

PTAS

JEFF A. MCDANIEL
P.O. BOX 684908
AUSTIN, TX 78768-4908

900204095

UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT RECORDATION BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE ASSIGNMENT RECORDATION BRANCH AT 571-272-3350. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, MAIL STOP: ASSIGNMENT RECORDATION BRANCH, P.O. BOX 1450, ALEXANDRIA, VA 22313.

RECORDATION DATE: 10/07/2011

REEL/FRAME: 4638/0070
NUMBER OF PAGES: 14

BRIEF: ASSIGNS THE ENTIRE INTEREST

DOCKET NUMBER: 6000-26800

ASSIGNOR:
AVAKIAN, SARKIS

DOC DATE: 09/29/2011
CITIZENSHIP: UNITED STATES
ENTITY: INDIVIDUAL

ASSIGNEE:
WHATABURGER PARTNERSHIP
300 CONCORD PLAZA DRIVE
SAN ANTONIO, TEXAS 78216

CITIZENSHIP: TEXAS
ENTITY: PARTNERSHIP

SERIAL NUMBER: 77494179
REGISTRATION NUMBER:
MARK: WHATTA WING!

FILING DATE: 06/09/2008
REGISTRATION DATE:

DRAWING TYPE: AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) IN
STYLIZED FORM

ASSIGNMENT RECORDATION BRANCH
PUBLIC RECORDS DIVISION